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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,839	09/27/1999	SIMON WILLIAM JONATHAN BRIGHT	PM-263754	9963

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EXAMINER

HELMER, GEORGIA L

ART UNIT PAPER NUMBER

1638

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/405,839

Applicant(s)

BRIGHT ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,28,38-50 and 52 is/are pending in the application.
- 4a) Of the above claim(s) 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 27,28,38-45,47-50 and 52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions – Supplemental

1. This is a supplementary restriction election to that issued 18 October 2002, now vacated, to which Applicant responded on 13 December 2002. Applicant elected Group I, claims 27, 28, 38-45, 47-50 and 52 drawn an expression system comprising recombinases.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 39, 40, 41, 28, 41-45 and 52 drawn to an expression system comprising recombinases classified in class 800, subclass 278, for example.
- II. Claim 27, drawn to an expression system comprising recombinases classified in class 800, subclass 278, for example.
- III. Claims 47-50, drawn to isolated plant genomes, classified in class 536, subclass 23.1, for example.

3. However, Group I claims are hereby restricted to specific recombinase systems from the group (A) – (C) as listed below. Applicant needs to elect one of these systems from the groups (A) –(C) for further prosecution, as well as one of the genes from group (i)-(ii). In choosing one of the groups (i)-(ii), Applicant need to chose one of the groups of genes of (a)-(b) if group (i) is chosen, or one of the groups (aa)-(cc) if group (ii) is chosen.

Recombinase systems:

- (A) FLP recombinase.
- (B) Cre recombinase.
- (C) Activator recombinase.

Genes:

- (i). A gene encoding a repressor protein (b)(i).
 - (a) where the repressor is the *lac* repressor (claim 44).
 - (b) where the repressor is a *tet* repressor (claim 45).
- (ii) A gene encoding an inhibitor (b)(ii), where the gene is under the control of
 - (aa) an inducible promoter and contains a disrupter gene promoter (claim 28).
 - (bb) inducible promoter of a glutathione-S-transferase (claim 42).
 - (cc) inducible promoter of a *A/cA* gene (claim 43).

In summary, if group I is chosen, Applicant needs to chose one of (A)-(C) and one of (i)-(ii). If group (i) is chosen, Applicant needs to further choose one of (a) or (b). If group (ii) is chosen, Applicant needs to further choose one of (aa), (bb) or (cc).

4. Inventions (A)-(C) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

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operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects. The recombinase systems have different starting materials, have different sequences and produce structurally different results.

Furthermore, FLP is a system native to yeast, Cre is a system native to bacteriophage, and Activator is native to plant.

5. Inventions (i)-(ii) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects. These repressor and inhibitor systems have different starting materials, are different and produce structurally different results.

6. Inventions (a)-(b) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects. Each of these repressor is different, has a different sequence, and has different properties.

7. Inventions (aa)-(cc) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different

functions, or different effects. Each of these inducible promoters is different, has a different sequence, and has different properties.

8. Inventions I/II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01. The Group III genomes can be made via a different system than the Groups I-II expression systems.

9. Inventions I and II are unrelated. The expression system of Group II is used to produce a specific plant characteristic, that of prevention of seed production. The expression systems of Group I are more general methods for production of a characteristic displayed in a plant.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

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12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

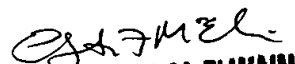
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer PhD
Patent Examiner
Art Unit 1638
February 24, 2003




ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800